No. 74-450

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

ALEXANDER P. BUTTERFIELD, ADMINISTRATOR OF THE FEDERAL AVIATION ADMINISTRATION, ET AL
Petitioners

v.

REUBEN B. ROBERTSON, III AND JEROME B. SIMANDLE
Respondents

BRIEF AMICUS CURIAE OF MARY HELEN SEARS

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AUTHORITY TO FILE

This brief is filed pursuant to Rule 42(2) of this Court. The letters of consent from both parties have been lodged with the Clerk and are reproduced *infra*, p. 1a-2a.

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. A, pp. 1A-16A) is reported at 498 F.2d 1031. The order of the district court (Pet. App. C, pp. 19A-20A) is not reported.

CONSTITUTIONAL AND STATUTORY PROVISIONS

The Constitution, Article I, Sec. 8, Clauses 3 and 8 and Article VI, Clause 2.

The Freedom of Information Act, as amended, 5 U.S.C. 552(a)(3), (b)(3) and (c).

The Patent Code, Title 35 U.S.C. 102, 103, 122 and 282.

Section 1504 of the Federal Aviation Act of 1958, 49 U.S.C. 1504.

These provisions are reproduced *infra*, p. 3a.

INTEREST OF AMICUS

Amicus curiae is the petitioner in No. 74-584, a presently pending petition for writ of certiorari involving a question identical to the question 1 before the Court. *Amicus* will accordingly be directly affected by the result of the case and hence wishes to be heard on points that the parties are not expected to brief.

In particular, the parties to this case No. 74-450 will not brief at least the following aspects of the identical question:

(a) whether the 5 U.S.C. 552(b)(3) provision for nondisclosure by the government of "matters specifically exempted from disclosure by statute", interpretation of which is the focus of the common question presented by the two petitions, is to be read in context with the intent and purpose of each individual statute of the "100", more or less, contended by the government to thus "specifically" exempt, rather than as a categorical generalization promulgated in furtherance of fostering overall governmental secrecy.

The specific statute involved, § 1104 of the Federal Aviation Act, does not afford a sufficient scope of constitutional, historical, legislative or precedent background on which to brief or argue even a sampling of the many individual federal policies which demonstrate the incorrectness of the government's broad scope argument in this case.

(b) important patent policy issues of fundamental constitutional importance subsumed in the identical question presented as it arises in No. 74-584, but which will not be briefed in this case because it involves only federal aviation law and policies.

SUMMARY OF ARGUMENT

1. Congress, in adopting the Freedom of Information Act, was faced with a large number of widely differing, preexisting statutes pertaining to the disclosure of information by the various administrative agencies. The Congress solved this problem in the FOI Act, by providing (i) in 5 U.S.C. 552(b), a series of nine guidelines which carefully define limits for the exercise of administrative discretion to withhold information, whether pursuant to statute or otherwise, and (ii) in specific exemption 3 of § 552(b) that only those statutes by which Congress itself had "specifically exempted" material would afford a *per se* statutory basis for withholding records otherwise subject to the disclosure provisions of § 552(a)(3). Had the Congress proceeded otherwise to qualify under exemption 3 all preexisting statutes which permit nondisclosure of requested records, the FOI Act would have been devitalized *ab initio.*

2. The basic differences in the language, purpose and legislative history of the several statutes contended by the government to fall within exemption 3 underlines the wisdom of the Congressional approach. The limited record before this Court in this case, based solely on § 1104 of the FAA Act, precludes a reasoned analysis of all such statutes and requires a strict construction of exemption 3.

3. The fundamental differences between the language and purpose of § 1104 of the FAA Act specifically at issue in this case and of § 122 of the Patent Code at

issue in No. 74-584 strongly emphasize the infeasibility of a blanket ruling qualifying all so-called "discretionary" statutes under exemption 3. These differences demonstrate that such a ruling would, in the case of § 122, raise new issues of constitutional dimension.

ARGUMENT

1. In No. 74-450, the government seeks a decision of this Court which "will largely resolve the issue of [exemption 3's] application to nearly 100 statutes . . ."[1] which admittedly "differ widely" (P. Br. 12).

The Court is ill-equipped, in the narrow compass of this case, to issue any such pervasive ruling. The "question presented" is far broader than the *single* issue decided below—*i.e.*, the question of whether § 1104 of the FAA Act qualifies under exemption 3 insofar as the SWAP reports are concerned.

Although a plurality of other appellate decisions involving the application of exemption 3 to other statutes and other records were substantially concurrently rendered, for various reasons—virtually in their entirety attributable to the government's acts—*none* of these decisions are before this Court for review.[2] Only this case—

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[1] Reply Memorandum for Petitioners, p. 3.

A similar gambit is attempted in No. 74-489, cert. granted February 18, 1975, in which the first "Question Presented" invites a broad ruling that exemption 6 "covers *all* personnel files" rather than, as the exemption itself states, only those "the disclosure of which would constitute a clearly unwarranted invasion of personal privacy".

[2] The applicability of exemption 3 to 42 U.S.C. § 1306(a) is the subject of at least *four* cases: *Stretch* v. *Weinberger*, 495 F.2d 609 (3 Cir. 1974); *Serchuk* v. *Weinberger*, 493 F.2d 693 (5 Cir. 1974); *Schechter* v. *Weinberger*, 506 F.2d 1275 (D.C. Cir. 1974); *People of California* v. *Weinberger*, 9 Cir., No. 73-1494 (1974).

[Footnote continued on page 5]

preselected by the government as most likely to result in the decision it seeks—is to be considered on its merits.

Because the many so-called "discretionary" statutes having different language, purposes and legislative histories, admittedly "differ widely" a blanket ruling *qualifying* all such legislation under exemption 3 is inappropriate.[3] No such blanket ruling cannot soundly be rendered on the basis of the limited record in No. 74-450 which involves only § 1104 of the FAA Act.

Congress was careful to avoid the hazards of such an ill-considered approach. Recognizing that the many "discretionary" statutes involved indeed "differ widely" and that specific legislative reconsideration and modification of each was impractical, Congress invoked the reasonable alternative of (i) providing in exemption 3, that agency withholding of records on *statutory* grounds is permitted only where, as a result of Congress' own acts, the requested material is "specifically" exempted by the statute itself, and (ii) requiring that administrative discretion, where countenanced by other statutes, be exercised strictly within the limits defined by the remaining exemptions.

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[2] [Continued]

"The government does not intend to petition for a writ of certiorari in Serchuk or Schechter. . .". Reply memo in Support of Pet. for Cert. in No. 74-450, P. 2, n. 1.

The applicability of exemption 3 to 35 U.S.C. § 122 is the subject of case No. 74-584.

The application of exemption 3 to § 613(c) of the Internal Revenue Code is the subject of the decision *Tax Analysts and Advocates* v. *Internal Revenue Service*, 505 F.2d 350 (D.C. Cir. 1974)—which conflicts with the Fourth Circuit's decision in Sears, *supra*. See the Petition in No. 74-584 at pp. 20-21.

No petition for writ of certiorari has been filed by the government in *Tax Analysts*.

[3] See the Petition in No. 74-584 at pp. 18-20 and the "Petitioner's Emergency Motion for Immediate Disposition of Pending Petition for Writ of Certiorari" in No. 74-584 at pp. 2-3.

Consonant with this approach, Congress also enacted § 552(c) to make it clear that agency withholding of records is *not* authorized *"except as specifically stated"* in the FOI Act.

2. It is common knowledge that "Not one executive branch agency, not one government official testified in favor of the [FOI] bill during the Subcommittee's hearings prior to its passage in 1966".[4] Post-enactment, agency resolve to defeat the Congressional purpose was furthered by the Attorney General's 1967 memorandum—in fact a partisan brief—which "is not the law . . . it reflects the point of view of the agencies, all of whom opposed enactment".[5] Not surprisingly, under the aegis of the Department of Justice, "The efficient application of the Freedom of Information Act has been hindered by 5 years of foot-dragging by the Federal Bureaucracy", and "The nine exemptions in the Act which permit withholding of information have been misused by the Federal agencies."[6]

3. Contrary to the letter and purpose of the FOI Act, the Attorney General's memorandum states that the reference to "nearly 100 statutes" which appears in the

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[4] "The Freedom of Information Act", Hearings Before Subcommittee of Committee on Government Operations, H. R. 93d Cong., 1st Sess., on H.R. 5425 and 4960, May 2, 7, 8, 10 and 16, 1973 (p. 2).

[5] Davis, "The Information Act: A Preliminary Analysis," 34 U. Chic. L.R. 761 (1967).

[6] Administration of the Freedom of Information Act, H.R. 92-1419, 92d Cong., 2d Sess., Sept. 20, 1972 (pp. 8; 11).

Congress has recently enacted P.L. 93-502 over the President's veto to limit exemptions 1 and 7 with a stated "intent to override" this Court's unduly broad interpretation of exemption 1 in *Environmental Protection Agency* v. *Mink*, 410 U.S. 73 (1973). Freedom of Information Act Amendments, S. R. 93-1200, 93d Cong., 2d Sess. (p. 12).

non-authoritative House Report[7] "apparently was inserted . . . in reliance upon a survey [not otherwise identified] conducted by the Administrative Conference of the United States in 1962" and on that basis speculates that the intention of Congress was "to preserve whatever protection is afforded under other [than the FOIA] statutes whatever their terms" (pp. 31-32).

In the present case, the government, in urging an affirmative answer to the "Question Presented", similarly contends that exemption 3 covers "*all* material with respect to which Congress by statute has provided for nondisclosure upon various terms, including statutes that give government officials discretion to decide whether to disclose" (P. Br. 2). Its brief adverts repeatedly to the aforesaid "100 statutes" and insists that exemption 3 extends to *all* statutes which "specifically require *or* permit nondisclosure of government information, without regard to the circumstances" and "whether or not they specify the particular documents to be kept confidential" (P. Br. 10)[8] and that "under exemption 3 the only function of a reviewing court is to determine whether there is a specific statute requiring or authorizing the confidentiality of the material involved" (P. Br. 15). These contentions totally conflict with Congress' own 1974 restatement of its intent in adopting the FOI Act.

In 1974, the Congress published the "Freedom of Information Act Source Book" "designed to provide the public with the arsenal necessary to obtain maximum disclosure from the departments and agencies of the government" (p. 3). Included in this "arsenal" is a "Discussion" and "Summary" of the legislative history, as well as 113 pages of "Legislative Materials: Senate and House Re-

[7] It is settled that the Senate report (S. Rep. 813, 89th Cong., 1st Sess. (1966) is the more reliable. See *Stokes* v. *Brennan*, 467 F.2d 699, 794 (5 Cir. 1973) and cases cited.

[8] See also P. Br. 11, 12, 13 and 14.

ports and Debates". It is careful to point out that the Attorney General's memorandum "should properly be considered *not* part of the legislative history" (p. 9, emphasis in original).[9] It emphasizes that:

> "The first Congressional attempt to formulate a general statutory plan to aid in free access occurred in 1946. . . .
>
> * * * *
>
> "Soon after the 1946 enactment, it became apparent that, in spite of the clear intent of Congress to promote disclosure, some of its provisions were vague and that it contained disabling loopholes which made the statute, in effect, a basis for withholding information." (p. 3)

and that

> "To remedy the weakness of existing law, the Senate Report [S. Rep. 1219, 88th Cong., 2d Sess. (1964)] stated the purpose of S. 1666 as: '. . . to eliminate such phrases [giving administrators discretion to decide whether to disclose] to establish a general philosophy of full agency disclosure *unless information is exempted under clearly delineated statutory language*. . . .'" (p. 4)[10]

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[9] Freedom of Information Act Source Book: Legislative Materials, Cases, Articles, Sen. Doc. 93-82, 93d Cong., 2d Sess. (1974), p. 8 (footnote omitted)—hereinafter referred to as "Source Book".

[10] The pertinent portion of S. 1666, Sec. 3(c)(i), like exemption 3, specified that "(c) Each agency shall . . . make its records promptly available except those which are (i) specifically exempt from disclosure by statute".

Senator Long's *pertinent* comments as to Sec. 3(c) state:

> "Section 3(c) contains the portion of the bill which has been most extensively revised. It requires that all agencies' records be made promptly available except in those cases where such records are: (1) *specifically covered by a statutory exemption*, as in the case of individual income tax returns" [see 26 U.S.C. § 6103]. See *infra*, p. 6a-7a.

Senator Long's comments quoted out of context at P.Br. 18 addressed a different Sec. 3(c) of S. 1666 are inapposite.

The government itself states "That legislative history of the specific exemption involved, however, must prevail . . ." (P.Br. 21).

The very reference in the early legislative history to "nearly 100 statutes" indicates strongly that the Congress had no intention to continue the unbridled discretion which these statutes, in common with the predecessor information statute, vest in the administrative agencies. Congress certainly recognized that to do so would defeat *ab initio* the very purpose of the new Act.

Having no practical way to consider separately each of the "nearly 100 statutes", the Congress was careful to make it clear:

(a) by § 552(c), that the Act "does not authorize the withholding of information or limit the availability of records to the public, except as *specifically* stated. . . ." [11]

(b) by exemption 3, that *the only* statutes which authorize withholding are those in which Congress *itself*, as distinguished from an administrator, "specifically"

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[11] "The purpose of this subsection [552(c)] was to make it clear beyond doubt that all materials of the Government are to be available to the public *unless specifically* allowed to be kept secret by the exemptions." S. Rep. 813, 89th Cong., 1st Sess. (1966). The corresponding House Report 1497 is in full accord. It states that "The purpose of this subsection [552(c)] is to make it clear beyond doubt that all materials are to be made available to the public unless specifically exempt from disclosure by the provisions of [the exemptions] or limitations spelled out in earlier sections".

As the Fourth Circuit noted in *Wellford* v. *Hardin*, 444 F.2d 21, 24-25:

> "A broad construction of the exemptions would be contrary to the express language of the Act . . . Speaking of this provision [§ 552(c)], one commentator has said:
>
> > 'The pull of the word 'specifically' is toward emphasis on statutory language and away from all else—away from implied meanings, away from reliance on legislative history, away from needed judicial legislation'.
>
> K. Davis, The Information Act: A Preliminary Analysis, 34 U. Chic. L. Rev. 761, 783 (1967)."

"exempted . . . [the requested material] under clearly delineated statutory language",[12] and

(c) that the exercise of administrative discretion under all other relevant statutes must be limited by and find sanction in one or more of the other exemptions.[13]

4. Congress has uniquely at pains to make its intentions quite clear that the paramount disclosure objective of the FOI Act is not to be subsumed by an overbroad interpretation of the nine exemptions.

In 1973, after this Court's generous interpretation, in *Environmental Protection Agency* v. *Mink*, 410 U.S. 73,

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[12] This is the view of at least the Third, Fifth and District of Columbia Circuits. See *Stretch* v. *Weinberger*, 497 F.2d 639, (3 Cir. 1974):

> ". . . We agree, as did the district court, that the *exempting statute must prescribe* some basis upon which the Secretary is to decide. Otherwise, there would be no escape from the unacceptable conclusion that the word 'specifically', as used in section 552(b)(3), is surplusage."

Serchuk v. *Weinberger*, 493 F.2d 663 (5 Cir. 1974); *Tax Analysts and Advocates* v. *Internal Revenue Service*, 505 F.2d 350 (D.C. Cir. 1974).

Petitioner's brief *incorrectly* states that the Fourth Circuit, in No. 74-584 "agreed with the interpretation of exemption 3 in Stretch" (p. 17, n. 16). In truth, the conflict in the decisions of the Third and Fourth Circuits "is direct and obvious". See the Petition in No. 74-584, p. 21. The Fourth Circuit's pretended "agreement" with the ruling in *Stretch* is sheer sophistry.

[13] It is facially apparent that § 1104 does *not* "specifically exempt" the SWAP reports—and hence that exemption 3 is not applicable. Thus, the "SWAP" reports, *if* they are to be suppressed, must be shown to qualify under an exemption other than 3, *e.g.*, under exemption 4's reference to "commercial . . . information obtained from a person and . . . confidential".

Based on the existing record, it appears that the realistic approach in this case—*if* identifying information such as the names of the involved airlines should be considered legitimately subject to withholding—would be to delete only that information before releasing the balance of the reports to the public. See n. 19, *infra*, p. 14.

of exemption 1, Congress took immediate remedial steps.[14] Included was the 1974 publication of the "Source Book", which in its "Introduction" states:

> "Most significantly, the courts appear to adopt and reinforce at each opportunity the congressional intent underlying passage of the Freedom of Information Act. For example, one Court of Appeals, after ordering disclosure of documents requested by the plaintiff but withheld by the government in a recent case, observed:
>
> > '. . . '. . . The touchstone of any proceedings under the Act must be the clear legislative intent to assure public access to all governmental records whose disclosure would not significantly harm specific governmental interests. The policy of the Act requires that the disclosure requirement be construed broadly, *the exemptions narrowly*'.[8]

"[8] Soucie v. David, 448 F.2d 1067, 1080 (D.C. Cir. 1971)"

Consonant with its "clear legislative intent" that the "exemptions" are to be "construed . . . narrowly", the Congress, over the President's veto, enacted P.L. 93-502 with the clear "intent to override the Supreme Court's holding in the case of EPA v. Mink."[15] and to clarify and restrict the scope of exemptions 1 and 7 where abuse consequent from overboard construction contrary to the policy of the Act was already manifest.

Unabashed, the government again appears before this Court urging a broad construction of exemption 3 in

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[14] The government emphasizes Mr. Justice Stewart's observations in *Mink*, 410 U.S. at 95, note, that exemption 3 is structured similarly to exemption 1. See P. Br. 10, 15.

[15] "Freedom of Information Act Amendments" S. Rep. 93-1200 93d Cong. 2d Sess.

clear derogation of the intent of Congress emphatically reiterated less than one year ago.[16]

5. The circumstance that "the discretionary statutes differ widely", emphasized at P.Br. 12, *et seq.*, argues strongly against the government's position that "By exemption 3, Congress intended to continue the effectiveness of all existing nondisclosure provisions" (P.Br. 13).

Per contra, Congress was careful to avoid a stillborn delivery of the FOI Act by expressly limiting exemption 3 to only that material which Congress *itself* "specifically exempted from disclosure by statute" and by defining in the remaining exemptions the outer limits for the exercise of administrative discretion to suppress information from the public.

> "It should be emphasized that the exemptions to the FOIA were not intended by Congress to be used either to prohibit disclosure of information or to justify automatic withholding of information. Rather, they merely mark the outer limits of information that may be withheld where the agency makes any affirmative determination that the public interest and the specific circumstances presented dictate that the information *should* be withheld. Agencies have been slow to adopt this attitude, but enlightened judicial decisions reflect this approach to interpreting the force of the FOIA exemptions." (Emphasis in original; "Source Book", p. 2)

6. Such an approach is essential to informed enforcement of the FOI Act—a circumstance sharply underlined by the conflicting considerations which are applicable to (1) § 1104 of the Federal Aviation Act specifically at

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[16] Similar government attempts to subvert the FOI Act's broad disclosure provisions by an overindulgent "interpretation" of its narrow exemptions are found in No. 73-1233, *National Labor Relations Board* v. *Sears, Roebuck & Co.* and No. 74-489, *Department of the Air Force* v. *Rose*, cert. granted February 18, 1975.

issue in No. 74-450 and (2) to § 122 of the Patent Code which is specifically at issue in No. 74-584.

According to the government, the public interest will be compromised if § 1104 **does not** qualify under exemption 3 because public disclosure of the "SWAP" reports "will necessarily adversely affect [the airlines'] voluntary cooperation" with the FAA and "the SWAP program will be seriously impaired" (P.Br. 26).[17]

In contrast, the public interest in the issuance of only valid patent monopolies and the "strong federal policy favoring full and free use of ideas in the public domain", *Lear* v. *Adkins*, 395 U.S. 653, 674 (1969), *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. ——; 94 S. Ct. 1879; 40 L. Ed.2d 315, 325 (1974), will continue to be seriously prejudiced *if* § 122 **does** qualify under exemption 3. Indeed, in such a case, a serious question of the constitutionality of both exemption 3 and § 122 is raised.

Similar dichotomy unquestionably exists as to the whole spectrum of "widely" different discretionary statutes. This circumstance, without more, precludes a blanket ruling on any informed basis as to the scope of exemption 3. Indeed, there is no record before this Court upon which such a blanket ruling could properly be posited, and in the absence of review of at least the other current cases involving the application of exemption 3 to various of these widely different statutes, no basis on which such a record could be presented. See n.2, *supra*, p. 4.[18]

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[17] These arguments represent mere self-serving conclusions of the FAA itself, and of the Air Transport Association, *unsupported* by specific factual evidence. As such, they should be disregarded, for failure to discharge the burden of proof imposed on the agency by § 552(a)(3).

[18] In these circumstances, a blanket ruling as to exemption 3 would be subject to the same criticism as that recently leveled against the decision in *Kewanee, supra,—i.e.*, that it "ignored many of the critical issues, dealt with others by making factual assumptions con-

(a) The petition states that the respondents in No. 74-450 seek "reports prepared by the . . . (FAA)" in connection with the SWAP program "which supplements the FAA's ordinary surveillance of airlines . . . and is intended to prevent unsafe conditions from arising . . ." and that "'[t]he system depends upon the frank and full disclosure of the airline" (Pet. 4-5). On this basis, it is urged that any construction of exemption 3 which would make the SWAP reports public "would severely undercut the Federal Aviation Administration's ability to properly fulfill its investigative duties" and that "If . . . those [SWAP] statements are to be made public, the airlines have indicated that their concern over the consequences of such disclosure will necessarily adversely affect their voluntary cooperation. Without that cooperation, the SWAP program will be seriously impaired" (P.Br. 26).[19]

These considerations have no relevance whatever to the issues arising in Case No. 74-584 under § 122 of the Patent Code.

(b) In No. 74-584, petitioner seeks access to so-called "abandoned" patent applications, *i.e.*, applications filed in the United States Patent Office on which patent protection has been refused or forfeited. The Fourth Circuit

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trary to experience and the record before it. . .". *Stern*, "A Reexamination of Preemption of Trade Secret Law After Kewanee," 42 Geo. W.L.R. 927, 930 (1975).

[19] These arguments should be presented, if at all, as reasons for deletion of material shown to be sensitive, *e.g.*, the identity of the airline involved, from the reports prior to production. They afford no justification cognizable under the FOI Act for suppression of an entire document. See § 2(c) of P.L. 93-502 requiring production of "reasonably segregable" portions of records.

Clearly, these factually unsupported arguments do not justify overturning the frequently reiterated intention of Congress that the exemptions are to be construed "narrowly", by a blanket ruling qualifying under exemption 3 all of the many statutes "which permit nondisclosure . . . without regard to the circumstances" (P.Br. 10).

Court of Appeals adopted a prohibited broad construction of exemption 3 to hold that, although the statute does *not* in terms, *i.e.*, "specifically", refer to them, these abandoned files are nevertheless "specifically exempted" by § 122 which provides:

> "Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner *unless necessary to carry out the provisions of any Act of Congress* or in such special circumstances as may be determined by the Commissioner".

In contrast to the FAA's necessary reliance upon "frank and full disclosure by an airline of all matters, including problems and defects", the inducement to file patent applications is the hope of acquiring a valuable asset—the private monopoly afforded by the patent laws.[20]

The success of the patent system does not depend upon the suppression of the unpatentable ideas contained in the abandoned applications of unsuccesful applicants. The Patent Office "admits that the substance of some abandoned applications has become public knowledge".[21] The agency has stipulated that "The Patent Office routinely

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[20] The Congress itself, in considering exemption 4, has recognized that:

> "A general principle should be considered, providing that the exemption shall not apply to information furnished by any person where the purpose of providing information is to secure a special financial benefit or privilege [e.g., a patent] from the federal government." op. cit. *supra*, n. 6, n. 6.

" 'The patent is a privilege . . . conditioned by a public purpose.' " *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation*, 402 U.S. 313, 314 (1972).

[21] Par. 25 of Answer to Complaint in No. 74-584 (App. I, pp. 13-20).

maintains in secret abandoned applications, the precise text of which has been laid open to public inspection" and that the Patent Office makes no "effort to ascertain whether or to what extent the subject matter of each abandoned patent application has been made publicly available".[22] Clearly, no Congressional purpose is served by the total agency suppression of these abandoned files under color of § 122.

A determination of whether § 122 is a statute which "specifically exempts" under exemption 3 requires a careful analysis of the evidentiary requisites of at least 35 U.S.C. §§ 102, 103 and 282 in light of the constitutional patentability standards. Such an analysis compels the conclusion that public access to abandoned patent applications is "necessary to carry out the provisions" of at least these "Acts of Congress". Hence, such applications

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[22] Stip. Pars. 26 to 29 (App. I, 42-53) in No. 74-584.

The practical experience in the United States and foreign countries contradicts the government's argument, advanced without record support below that publication of abandoned applications may conflict with the policy of the patent clause by discouraging inventors from applying for patents. For the first three-quarters of the century of the operation of the patent system, abandoned applications were published and were used as prior art against pending cases. As noted *supra*, the content of many abandoned patent applications *is* now published—without adverse effect on the patent system. Pending legislation to revise the United States patent laws would require the publication of virtually all patent applications, pending and abandoned. See, *e.g.*, S. 473, 94th Cong. 1st Sess., §§ 122; 135. Such revision accords with the long standing practice in most foreign countries to publish applications with leave to any member of the public to oppose the patent grant. See, *e.g.*, *McKie*, "Proposals For an American Patent Opposition System in Light of the History of Foreign Systems" 56 J.P.O.S. 94 (1974). The result in such countries has not been a decrease in the number of applications filed, but an *increase* in the quality of issued patents. See the Petition in No. 74-584, p. 28, n. 40 and associated text.

are excluded from § 122's confidence provisions by that section's *own* words of exemption.[23]

In sharp contrast to the alleged adverse consequences of publication of the SWAP reports on the administration of the FAA Act, the administration of the patent laws is severely prejudiced by agency *suppression of the evidence germane to patentability* which the abandoned application files admittedly contain.

Thus, it is stipulated that "At least some abandoned . . . applications are evidence of the level of skill in the art . . . as of their filing date",[24] *i.e.*, the very yardstick which this Court has twice stated is to be used in applying the "obviousness" standard of § 103 of the Patent Act to the "differences" betwen the "prior art" and the patent claims to gauge the presence of constitutionally patentable invention. *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966). *Anderson's Black Rock* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969). Moreover, under the presumed authority of § 122, the Commissioner not only suppresses the "skill in the art" evidence (which need not be public)[25] that is present in the abandoned files—

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[23] In fact, public access to abandoned application is "necessary to carry out the provisions of § 553(a)(3) itself, which was enacted in 1967, some 15 years after the 1952 Patent law revision. "The broad language of the FOIA, with its obvious emphasis on disclosure and with its exemptions carefully delineated as exemptions", *Renegotiation Board* v. *Bannercraft Clothing Co.*, 415 U.S. 1 (1974), makes it clear that "*disclosure*" is indeed essential to "carry out" *its* provisions, absent clear, express and specific statutory authorization for agency suppression. Rather than authorizing such suppression, § 122 itself deprives the Patent Commissioner of discretion and so mandates publication of all material requisite to satisfy the disclosure objective of the FOI Act.

[24] Stip. Par. 12, App. I, 35 in No. 74-584.

[25] *International Glass Co.* v. *United States*, 408 F.2d 395, 404 (Ct. Cl. 1969); *Servo Corp. of America* v. *General Electric Co.*, 337 F.2d 716 (4 Cir. 1964), cert. den. 383 U.S. 934; *Felburn* v. *New York Central Railroad*, 350 F.2d 416 (6 Cir. 1965); *United States Pipe & Foundry Co.* v. *Woodward Iron Co.*, 327 F.2d 442 (4 Cir.

but with premeditation also imposes "secrecy" to *disqualify* unpublished abandoned patent applications as statutory "prior art" under § 102(a) and (b) on the sole ground that *because* of the *agency's* secrecy rule, the suppressed applications are not "public" within the meaning of these statutes. As the agency put it below ". . . nonreliance by the Patent Office upon abandoned applications and preserving them in secrecy are opposite sides of the same coin".[26]

The net result of this—and other Patent Office rules of expediency which compromise the meaningful examination of patent applications—is the "notorious difference

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1964); *Package Devices, Inc.* v. *Sun Ray Drug Co.*, 301 F.Supp. 768 (E.D.Pa. 1969), aff'd 432 F.2d 272 (3 Cir. 1970).

The *un*published activities of a plurality of individuals resulting in substantially the same solution to substantially the same problem at substantially the same time has long been recognized as cogent evidence that the "level of skill" in the pertinent art was such as to preclude patentability. See *Concrete Appliances Co.* v. *Gomery*, 269 U.S. 177 (1925); *Kay Products Corp.* v. *Martin Supply Co.*, 202 F.2d 47 (4 Cir. 1953). In *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 326 (1945), this Court, invalidating the patent in suit, found that a private unpublished report emanating from the Gypsy Oil Company was qualified as evidence of the level of skill even if an "abandoned experiement not amounting to anticipation."

[26] The Patent Office has stipulated that:

> "18. Abandoned U.S. patent applications which are referred to in issued patents [and hence publicly available] are relevant when utilized by the Patent Office in examining patent applications for compliance with 35 U.S.C. 102 and 103 pursuant to 35 U.S.C. 131, 132 and 134, by the courts pursuant to 35 U.S.C. 141 to 146 inclusive in reviewing Patent Office decisions and by the courts under 35 U.S.C. 281 and 282 in adjudicating the validity of issued patents." (App. I, 39 in No. 74-584).

—and indeed that:

> "25. Under present practice of the Patent Office any document which can be proved to be publicly available anywhere in the world may be used as a reference against a pending patent application. . . ." (App. I, 42 in No. 74-584).

between the standards applied by the Patent Office and the courts", *Graham, supra,* 383 U.S. at 18; see *Kewanee Oil Co.* v. *Bicron Corp.*, 412 U.S. 546, 5— (1974)[27] the consequent grant of "A significant number of patents . . . for trivial inventions" and "the sagging reputation of the patent system".[28]

7. Against this background, the fundamentally different language and purpose of § 122 of the Patent Act and § 1104 of the FAA Act are of controlling significance. In § 122, Congress has expressly provided that the statute's discretionary "confidence" provisions shall *not* apply to any material

> ". . . necessary to carry out the provisions of any Act of Congress. . .".[29]

Under *this* provision—which has no counterpart in § 1104—the Commisioner has **no** discretion to withhold **any** such "necessary" material from the public or by the im-

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[27] In contrast to the Patent Office suppression thereof, the Federal Courts routinely consider abandoned patent applications as evidence germane to patentability (validity of issued patents) whenever it is available. See *Smith* v. *Hall*, 301 U.S. 216 (1937) and *Package Devices, Inc., supra.*

Consonantly the *courts* routinely act to compel production for use in patent litigation of both pending and abandoned patent applications notwithstanding § 122 and such rules as 37 C.F.R. 1.108 and 1.14. *See, e.g., James B. Clow & Sons, Inc.* v. *United States Pipe & Foundry Co.*, 313 F.2d 46 (5 Cir. 1963); *Carrier Mfg. Co.* v. *Rex. Chainbelt, Inc.*, 281 F.Supp. 717 (E.D. Wis. 1968).

The dichotomy between the Patent Office and the courts as to the evidentiary effect of abandoned patent applications in the adjudication of patentability and patent validity questions is discussed at p. 22, *et seq.* of the Petition in No. 74-584.

[28] Marquis, "Improving the Quality Control of Patents", 59 Minn. L.R. 67, 79 (1974).

[29] The Fourth Circuit—unable to harmonize its holding that § 122 vests discretion in the Commissioner to suppress the very material which this clear provision specifically excludes from any "confidence"—simply ignored it. See Pet. in No. 74-584, p. 14, *et seq.*

position of "secrecy", to disqualify it as prior art cognizable under the patent laws.[30]

This provision places § 122 in an entirely separate category from statutes like § 1104 which contain no parallel words. This fundamental difference in the wording and purpose of the involved statutes seriously challenges the propriety of a blanket ruling construing exemption 3 broadly to include both § 1104 and § 122 as the government urges.

Faced with problems of this type, Congress made no effort to consider each of the "nearly 100 statutes" but instead provided in exemption 3 that *only* where the *statutes themselves* "specifically exempt" is agency suppression of any material on *statutory* grounds alone to be permitted. To the extent that any of the "nearly 100 statutes" give government officials discretion to decide whether to disclose", that discretion is to be exercised strictly within the limits defined by the other exemptions which must be narrowly construed to insure that the objectives of the FOI Act are realized. This Congressional approach is reasonable and should be adopted by this Court.[31]

8. Serious doubt as to the constitutionality both of exemption 3 and § 122 arises under the Patent Clause of

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[30] As is apparent from the final, and alternative, *discretionary* provision "*or* in such special circumstances *as may be determined* by the Commissioner" to warrant disclosure.

[31] The government states that "one strong indication that § 1104 was among the nondisclosure statutes Congress intended to preserve in enacting exemption 3 is the fact that it was specifically mentioned in a list of nondisclosure statutes submitted to Congress during the *1958* hearings . . . " (P.Br. in 74-450, p. 11, 23-24).

It is much more reasonable to conclude that Congress, almost ten years later in 1967, did not wish to reexamine all of these statutes and prescribe new guidelines for each—and hence left intact only those statutes in which Congress *itself* had already "specifically exempted" identified material from disclosure. The 1974 "Source Book" strongly supports this conclusion.

the Constitution as these statutes are applied to permit the continued suppression by the Patent Commissioner of evidence—admittedly contained in the abandoned files—requisite to the discharge of his duty to grant private monopolies for *only* those "inventions" which satisfy the constitutional patentability standard.[32]

Nor can their application of exemption 3 and § 122 be legitimatized on the pretext of justifying "assurances" by the Commissioner to unsuccessful applicants that the unpatentable ideas, *whether or not secret*, which are con-

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[32] As held in *Graham, supra*, and restated in substance in *Anderson's Black Rock, supra*, the patentability "standard expressed in the Constitution . . . may not be ignored. And it is in this light that patent validity 'requires reference to a standard written into the Constitution'. A&P Tea Co. v. Supermarket Corp., supra, 340 U.S. at 154. . . ." The constitutional patent clause "is both a grant of power and a limitation", a qualified authority . . . limited to the promotion of advances in the 'useful arts' "; the "Congress in the exercise of the patent power may *not* overreach the restraints imposed by the stated constitutional purpose". *Only* "[w]ithin the scope established by the Constitution, Congress may set out conditions and tests for patentability" 383 U.S. at 5, 6, 35 U.S.C. § 103 "comports with the constitutional strictures", 383 U.S. at 17, *only* if construed and applied in a manner to implement and not to denigrate the constitutional patentability standard. It is stipulated that "the constitutional standard for patentable invention . . . [is] now codified in 35 U.S.C. 103" (Stip. Par. 23, App. 42).

In 1969, the Court in *Lear* v. *Adkins*, 395 U.S. 653, adverted to the "demanding standard of invention explicated in our decision in Graham v. John Deere Co.", 395 U.S. at 676, and to "the important public interest in permitting full and free competition in the use of ideas which are in reality a part of the public domain", 395 U.S. at 670. In 1971, in *Blonder-Tongue, supra*, the Court said:

> ". . . A patent yielding returns for a device that fails to meet the congressionally imposed *criteria of patentability* is anomalous. . . .". 402 U.S. at 343.

tained in abandoned patent applications will be suppressed from the public.[33]

Contrary to this approach, it is "the duty" of this Court and of the Patent Office "to avoid a construction that would suppress otherwise competent evidence unless the statute, strictly construed, requires such a result". An "assurance" even by the President that "gives the statute" a meaning which it does not require is totally inoperative. See *St. Regis Paper Co.* v. *United States*, 368 U.S. 208, 219 (1961).

Nor can agency imposition of secrecy somehow be justified on the speculative pretext of the protecting unidentified trade secrets in those *few* abandoned applications which may disclose them.[34] The agency attempt to

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[33] The final agency denial of the *Sears* request for abandoned patent applications states that "in reliance on [§ 122] inventors make full disclosure of their inventions in patent applications with the assurance that the valuable trade secrets therein will be disclosed to the public only at the inventor's option. . . ." (Pet. in No. 74-584, p. 5, n. 4).

Contrary to this representation, Congress *requires* "full disclosure" of inventions in patent applications in 35 U.S.C. § 112 which provides that "the specification shall contain a written description of the invention and of the manner of making and using it in such full . . . terms as to enable any person skilled in the art . . . to make and use the same. . . ."

Agency application of § 122 to suppress *non*secret ideas clashes head-on with the "strong federal policy favoring full and free use of ideas in the public domain", *Lear* v. *Adkins*, 395 U.S. at 674.

The agency nondisclosure "assurance" under color of § 122 clearly extends to *nonsecret* ideas. See the discussion *supra*, p. 15-16.

[34] The Patent Office has stipulated:

"Applicants do not record in writing or otherwise any identification of any alleged trade secrets in the patent applications they cause to be filed." (Stip. Par. 26, C. A. App. I, 19).

[Footnote continued on page 23]

justify its unauthorized "assurance" on a "trade secret" pretext is particularly anomalous since "The U.S. Patent Office has no right under any statutory or constitutional provision or on any other basis to recognize any sort of proprietary right in subject matter it has adjudged unpatentable" (Stip. Par. 51, App. I, 48 in No. 74-584).

§ 122 and exemption 3 are invalid as applied in this manner to hobble the Patent Office in the discharge of its sole *legitimate* mission of weeding out constitutionally inadequate patent applications.

Patent Office subordination of the patent system to the state law of trade secrets is precluded by the Constitution's "limitation on the states . . . that in regulating the area of patents and copyrights, they do not conflict with the operation of the laws in this area passed by Congress". *Kewanee, supra*, 416 U.S. at ——, 40 L Ed 2d at 324.

As this Court has recognized virtually from the beginning, trivial and undeserving patents preempt the skills essential to the normal "progress of science and the useful arts" and hence are constitutionally precluded.

> " 'To grant a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above the ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences." *A&P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 155 (1950), quoting *Atlantic Works* v. *Brady*, 107, U.S. 192, 199-200 (1883). (Mr. Justice Douglas

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[34] [Continued]

When pressed to discharge its burden under § 552(a)(3) to show that *any* abandoned patent application contained a trade secret, the Patent Office, by a post-trial motion, confessed that at most, *only* 24% of abandoned applications *may* contain trade secrets—and so admitted that at least 76% did not. See the Petition in No. 74-584, pp. 11-12, including n. 16.

concurring; the concurring opinion in A&P was adopted in explication of the constitutional patentability standard in *Graham, supra*, and reiterated in *Anderson's Black Rock, supra*.)

"It was never the object of those [patent] laws to grant a monopoly for every trifling device", *id.*, for such monopolies impede the fundamental right of every citizen to the free exercise of ordinary skills in the pursuit of a calling. *Greene* v. *McElroy*, 360 U.S. 474 (1959); see also *Allgeyer* v. *Louisiana*, 165 U.S. 578, 589-590 (1886) and so contravene the substantive due process standard of the Fifth Amendment.[35]

9. These constitutional questions must be squarely faced and promptly resolved in a proper three-judge forum if exemption 3 is afforded the blanket, broad construction requested by the government whereby *all* statutes—including § 122—are qualified "which specifically *require* or *permit* nondisclosure without regard to the circumstances" and "whether or not they specify the particular documents to be kept confidential" (P. Br. 10), thus reducing the "function of the reviewing court to [determing] whether there is a specific statute requiring or authorizing the confidentiality of the material involved" (P. Br. 15). *Hagans* v. *Lavine*, 415 U.S. 528 (1974); *Goosby* v. *Osser*, 409 U.S. 512, 518 (1973).[36]

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[35] See "The Constitutional Standard of Invention—The Touchstone for Patent Reform," 1973 Utah L.R. 653, 672-674.

[36] As recently as February 18, 1975, the Court has pointed out that:

> "We recently stated 'claims are constitutionally insubstantial only if the prior decisions inescapably render the claims frivolous; previous decisions that merely render claims of doubtful or questionable merit do not render them insubstantial for the purpose of 28 U.S.C. § 2281.' Goosby v. Osser, 409 U.S. 512, 518 (1973)." *Harris County Commissioners Court* v. *Moore*—43 U.S.L.W. 4223, 4224, n. 6.

The Fourth Circuit in No. 74-584 misstated and then, in the guise of pronouncing them insubstantial, adjudicated the merits

CONCLUSION

The decision of the Court of Appeals in No. 74-450 should be affirmed. This Court should follow the lead of Congress to hold that exemption 3 does not broadly include all of the widely different "discretionary" statutes which either permit or require any administrative agency to suppress material from the public. As exemption 3 states in terms, *only* those statutes which themselves "specifically" exempt material are subject to its provisions. The exercise of administrative discretion under other statutes must find sanction in one or more of the other exemptions.

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of petitioner's constitutional claims—all without a semblance of a "prior decision" which "inescapably renders" them "frivolous" and pointedly without reference to either *Goosby* or *Hagans*. A Request for Reconsideration stressing the appellate court's non-compliance with the rule enunciated in *Goosby* and *Hagans* was summarily denied. See the Petition in No. 74-584, pp. 16a to 19a, and the discussion at pp. 14-18 and 22-28.

The Petition in No. 74-584 is being supplemented to focus more directly on this issue in view of the review granted in No. 74-450, coupled with the February 18, 1975 denial of the Motion to Expedite Consideration of the Petition.